Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS R. VERENSKI

Appeal No. 1999-0639
Application No. 08/592,109[1]

ON BRIEF

Before COHEN, McQUADE, and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 13, which are all of the claims pending in this application.

We REVERSE.

[1] Application for patent filed January 26, 1996.

BACKGROUND

The appellant's invention relates to a ladder system, a ladder rail, a method of climbing the ladder and a method of forming the ladder. Of importance to the appellant is the provision of a non-linear (curved) slot in the ladder rail of the invention for pivotal attachment of a ladder shoe. An understanding of the invention can be derived from independent claims 1, 10, 11 and 13, which are reproduced in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Kiska	5,370,203	Dec. 6, 1994

The following rejections are before us for review.

Claims 1 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kiska.

Reference is made to the brief (Paper No. 9) and the answer (Paper No. 10) for the respective positions of the

appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims[2], to the applied Kiska patent, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we shall not sustain the examiner's rejection for the reasons which follow.

Claims 1 through 9 recite a ladder system comprising, *inter alia*, first and second rails having first and second non-linear slots, respectively, in proximity to the bottom thereof. Claim 10 recites a ladder rail comprising a web portion and a flange portion extending from the web portion and having a non-linear rail slot in the web portion through which a bolt extends for attaching a ladder shoe to the web

[2] In reviewing claim 10, we note that the body of the claim, which recites a bolt extending through the non-linear rail slot of the web portion of the rail, does not appear to be commensurate in scope with the preamble of the claim, which recites only a ladder rail and not a ladder rail in combination with a bolt. Further, "its flange section" in claim 13, lines 2 and 3, lacks antecedent basis in the claim. We leave these issues to be addressed in the event of any further prosecution before the examiner.

portion. Claims 11 and 12 recite a method of climbing a ladder having a curved slot in the rails thereof and claim 13 recites a method of forming a ladder comprising steps of piercing curved slots in the ladder rails. As explained on page 2 of the appellant's specification, "a shoe that contains a curved slot must be made larger than others to contain the curved slot." According to the appellant, providing the non-linear slot in the rail allows for a "smaller, lighter weight and cheaper shoe."

In rejecting claims 1 through 13 as being unpatentable over Kiska, the examiner recognizes that the Kiska ladder differs from the claimed invention in that Kiska discloses provision of non-linear slots (62) in side plate portions (56, 58) of rail attachment portions (12) of ladder shoes (10) attached to the bottom of ladder rails (14), while these claims require the non-linear slot to be in the ladder rail. To overcome this deficiency, it is the examiner's position that "it would have been an obvious matter of reversal of parts to one of ordinary skill in the art to have the slot in the rail web rather than the ladder foot" (answer, page 5). The examiner adds that

> [t]here are only two possible locations for the slot, the ladder rail or the ladder foot. It would be desirable to locate the slot in the ladder rail since the rail would require only one piece to be cut, whereas locating the slot in the ladder foot would require two pieces to be cut and create potential for slot misalignment due to bending of the parallel ladder foot members" [answer, page 7].

The appellant argues, *inter alia*, that there is no basis in the prior art to arrive at the appellant's invention and that the examiner's conclusion of obviousness is grounded upon impermissible hindsight (brief, page 16). We agree with the appellant.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The only rationale offered by the examiner to support the conclusion that the proposed modification would have been obvious is that location of the non-linear slot in the rail

rather than the ladder shoe would require only one cut rather than two cuts, thereby minimizing potential for slot misalignment due to bending of the parallel ladder foot members. However, the examiner has not supported this contention with evidence that slot misalignment is a problem associated with the construction disclosed by Kiska. There is certainly no indication that Kiska recognized such a problem and it is not apparent to us that the arrangement disclosed by Kiska (two aligned slots in the side plate portions of the ladder shoe flanking an aligned aperture in the ladder rail) would necessarily present any increased potential for misalignment as compared with the modified arrangement proposed by the examiner (two aligned apertures in the side plate portions flanking an aligned slot in the ladder rail). Accordingly, it appears to us that, in rejecting claims 1 through 13, the examiner has relied on impermissible hindsight using the appellant's claims as a template to reconstruct the invention.

Moreover, with regard to claims 11 and 12, contrary to the examiner's assertion (answer, page 5), we find no teaching in Kiska of the steps of placing the feet of the ladder shoes

on the ground "with the rails vertically oriented relative to the ground" and rotating the rails of the ladder system relative to the ladder shoes at least 15 degrees as claimed. Similarly, with regard to claim 13, we find no teaching in Kiska of the steps of piercing a first rail with a first curved slot while a first rail is oriented with its flange facing up and piercing a second rail with a second curved slot while the second rail is oriented with its flange facing down, as required by the claim.

For all of the foregoing reasons, we shall not sustain the examiner's rejection of claims 1 through 13 under 35 U.S.C. § 103 as being unpatentable over Kiska.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 through 13 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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